

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Net al.

Serial No. 09/145,180

Filed: September 1, 1998

For: OXO-SUBSTITUTED COMPOUNDS, PROCESS OF MAKING,
AND COMPOSITIONS AND METHODS FOR INHIBITING
PARP ACTIVITY

Atty. Ref.: 2824-9

Group: 1617

Examiner: Wang, S.



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August 30, 2001

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

INFORMATION DISCLOSURE STATEMENT

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith. It is further understood that the Examiner will consider information that had been cited

by or submitted to the U.S. Patent and Trademark Office in a prior application relied on under 35 U.S.C. § 120. 1138 OG 37, 38 (May 19, 1992).

The attached PTO-1449 forms indicate the document number ("Doc No.") relating to each listed document. Documents which have been previously considered are indicated as "Duplicate" in the "Examiner's Initials" column. A copy of each of the listed documents is attached. Documents numbered through number 549 are attached on the attached CD disk and may be accessed, reviewed, and printed, if needed, as described below. A paper copy of documents 550-568 is attached.

The documents on the CD disk may be accessed, reviewed, and printed, if need be, as follows. After placing the CD in the CD drive, review the contents of the disk such as, for example, by use of Windows Explorer. Load the program "Cdview.exe" by, for example, double left - clicking on the icon for the same in the Explorer Window. This will load a program "Ipro Tech" and present the first document, which is document zero on the disk. The first document (document zero) on the disk is a copy of the index of the numbered documents. Each document on the disk is identified by a nine digit identifier wherein the first three digits identify the document number and the remaining digits identify the page of each document. The index which is first presented can be seen to contain ten pages wherein page 1 is shown. See, the top border of the program screen. The documents may be viewed smaller or larger using the "-" or "+", respectively, in the magnifying glass icons shown along the top of the program screen. Pages of the first document may be viewed in successive order using the greater than symbol, along the bottom border of the program screen, which is second from the left in the series of buttons. The last page of the index (document zero), or any document, may be viewed by clicking on the fourth button from the left along the bottom screen of the program. Successive or previous documents may be viewed by clicking on the directional arrows shown over a picture of a folder, which are the seventh and eighth buttons from the left along the bottom border of the program screen.

Alternatively, documents may be more directly accessed by left clicking on the "File" word along the top border of the program screen and then left clicking on the "Goto Image" words, followed by entry of the nine digit identifier described above in the "Enter Image Key" screen presented. The "Enter" key on the keyboard may be then pressed or the "OK" button left clicked to move to the desired document.

Again, the documents are numbered according to those found in the attached PTO-1449 form with a nine digit code wherein the first three digits identify the document number and the

remaining six digits identify the page number within the document which is requested. For example, document no. (Doc No.) 468 is indicated in the attached PTO-1449 form as being U.S. Patent No. 932,290. This document may be accessed, viewed, and printed, if need be, by left clicking on the "File" and then "Goto Image", as noted above, followed by entry of the number 468000001, for document number 468, page 1. Upon left clicking on "OK" or pressing "Enter" on the keyboard, the image of page 1 of U.S. Patent No. 932,290 appears. Separate pages of the document may be viewed and/or accessed, as described above.

Individual pages may be printed or entire documents may be printed by left clicking on the printer icon along the top of the viewer and clicking on the "Current Page Only", "Entire Document", or other desired option.

The Examiner is requested to contact the undersigned if questions arise or if anything further is required.

Applicants have checked the appropriate boxes below.

1. ☒ This Information Disclosure Statement is being filed within three months of the U.S. filing date OR before the mailing date of a first Office Action on the merits. No statement under 37 C.F.R. § 1.97(e) or fee is required. In the event, a first Office Action has been mailed prior to filing of the present Information Disclosure Statement, the Office is requested to treat the present paper as submission under 37 C.F.R. § 1.97(c) and charge the undersigned's Deposit Account No. 14-1140 for the fee required by 37 C.F.R. § 1.17(p). The present paper is submitted in duplicate for this purpose.

2. ☐ This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection or Notice of Allowance.

- a. ☐ I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- b. ☐ I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more

than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

- c. ☐ Attached is our Check in the amount of \$180 in payment of the fee under 37 C.F.R. § 1.17(p).

3. ☐ This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. It is hereby requested that the Information Disclosure Statement be considered. Attached is our Check No. in the amount of \$ in payment of the fee under 37 C.F.R. § 1.17(i).

- a. ☐ I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).

- b. ☐ I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).

4. ☐ Relevance of the non-English language document(s) is discussed in the present specification.

5. ☒ Some of the document(s) was/were cited in a corresponding foreign application. An English language version of the foreign search reports is attached for the Examiner's information.

6. ☐ A concise explanation of the relevance of the non-English language document(s) appears below:

7. ☒ The Examiner's attention is directed to co-pending U.S. Patent Application Nos. listed in the following table, (copies attached as the noted document numbers) which are directed to related technical subject matter. The identification of this U.S. Patent Application is not to be construed as a waiver of secrecy as to these applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited application

and the art cited therein during examination and return an initialed copy of the following Table as an indication of the same.

Examiner's Initials	Doc. No.	U.S. Application No.	Year	Applicant	status
S. V.	80	08/922,520	1997	Jackson et al.	abandoned
	96	08/922,575	1997	Jackson et al.	abandoned
	97	08/922,548	1997	Jackson et al.	pending
	549	09/387,767	1999	Li et al.	allowed
	1	09/224,294	1999	Zhang et al.	U.S. Patent No. 6201020
	7	09/224,293	1998	Zhang et al.	pending
	16	09/145,180	1998	Li et al.	pending
	17	09/145,184	1998	Li et al.	pending
	18	09/145,185	1998	Li et al.	U.S. Patent No. 6121278
	19	09/079,514	1998	Li et al.	abandoned
	20	09/079,510	1998	Li et al.	abandoned
	21	09/079,509	1998	Li et al.	abandoned
	22	09/047,502	1998	Li et al.	allowed
	27	09/145,179	1998	Jackson et al.	pending
	28	09/145,178	1998	Jackson et al.	pending
	29	09/145,177	1998	Jackson et al.	abandoned
	30	09/145,176	1998	Jackson et al.	pending
	31	09/145,166	1998	Jackson et al.	U.S. Patent No. 6197785
	32	09/079,513	1998	Jackson et al.	abandoned
	33	09/079,512	1998	Jackson et al.	abandoned
	33	09/689,942	1998	Jackson et al.	pending
	34	09/079,511	1998	Jackson et al.	abandoned
	35	09/079,508	1998	Jackson et al.	pending
	36	09/079,507	1998	Jackson et al.	abandoned

Examiner: S. V. Date Considered: 11-30-01

8. ☐ Copies of the documents were cited by or submitted to the Office in Application No. , filed , which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and to indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 14-1140 referencing docket number 2824-9 for any fee required for consideration of the attached.

Return of an initialed copy of the attached, pursuant to MPEP § 609, is requested.

LI et al.
Serial No. 09/145,180

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



B. J. Sadoff

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